

## REMARKS

Favorable reconsideration of this application, as amended, is respectfully solicited.

In the Official Action, Claims 58 and 75 are objected to as allegedly containing grammatical informalities. In response, applicants have amended Claims 58 and 75 in a manner as shown above. Since no new matter is introduced, entry thereof is respectfully requested. In view of the amendments to Claims 58 and 75, applicants submit that the instant objection has been obviated.

Further, Claims 58-73 and 75 stand rejected under 35 U.S.C. §112, second paragraph, as allegedly failing to particularly point out and distinctly claim the subject matter which applicants regard the invention. Specifically, the Examiner has contended that the “recitation in step (d) in Claims 58 and 75 wherein the composition of step (c) is [optionally] milled to a mean particle size of 0.1-0.4 mm requires that the microcrystallized particles obtained after the conditioning steps are 5-10  $\mu$ m in size, renders the claims herein indefinite”, alleging that it is unclear what applicants “are intending to claim since the final milled particle size in step (d) is larger than the particle size prior to milling”. Office Action page 4.

In response, applicants respectfully submit that the metes and bounds of the claims are clearly delineated. Specifically, step (c) refers to the size of the microcrystals. But, in step (d), the microcrystalline polyol composition from step (c) is optionally milled into granules, each containing a plurality of microcrystals, and the resulting polyol composition granules have a mean particle size of 0.1-0.4 mm. Attention in this matter is specifically directed to the instant specification at page 11, whereby the first paragraph provides:

“The terms “microcrystalline” and “microcrystal” as used throughout the present specification and claims should be understood to mean very small crystals produced by

the above fluidized microcrystallization technique and having a size which on an average is below 50. The crystals generally have a size in the order of about 5 to 10  $\mu$ , on an average, or even less.”

Regarding granules, attention is directed to the specification at page 12, wherein the first paragraph states:

“Although the size of the granules of the granular product obtainable according to the present invention is not critical and may vary according to the intended use of the product, the mean particle size of the polyol composition granules is generally between about 0.05 and 2.0 mm. The preferred mean particle size is generally about 0.1-0.4 mm. Each granule contains a mass of minute microcrystals. The particle size and particle distribution of the granules may be controlled to suite the intended use.”

Thus, where the claims are read in light of the teachings in the specification, contrary to the allegations in the Office Action, it is respectfully submitted that there is no inconsistency or ambiguity between steps (c) and (d) of claim 1.

In view of the above remarks, applicants submit that the instant rejection has been obviated, and reconsideration and withdrawal of the same is respectfully requested.

Further, Claims 58-60, 62-73 and 75 are rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 6,764,706 B1 to Heikkila et al. (“the ‘706 patent”) in view of US Patent No. 5,017,400 to Olinger et al. (“the ‘400 patent”).

In response, applicants submit that, based upon 35 U.S.C. §103 (c), the ‘706 patent cannot qualify as valid prior art against the present application.

Specifically, applicants observe that the ‘706 patent is rejected under 35 U.S.C. §103(a) by the Examiner through 35 U.S.C. §102(e).<sup>1</sup> See the last paragraph at page 4 of the Official Action.

Second, applicants respectfully submit that although the assignee of the ‘706 patent is reported to be Xyrofin OY, Xyrofin OY has merged with Danisco Sweeteners OY in

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<sup>1</sup> The publication date of the ‘706 patent was July 20, 2004, which is after the effective U.S. filing date of the present application which is July 2, 2003, thus, the ‘706 patent is a reference under 35 U.S.C. §102(e).

2001. Moreover, applicants respectfully submit the effective U.S. filing date of the present application was July 3, 2002. Further, applicants respectfully submit that at the time the present invention was made, the '706 patent and the present invention were owned **by the common owner, which is Danisco Sweeteners OY, or was subject to an obligation of assignment to Danisco Sweeteners OY**. In this regard, applicants enclose a statement of common ownership under 35 U.S.C. §103(c). As further evidence that Xyrofin OY merged with Dasnisco Sweeteners OY, we are enclosing a copy of a trade register extract indicating the merger of Xyrofin Oy into Danisco Sweeteners OY.

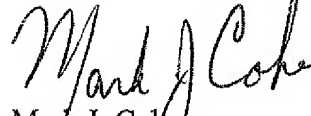
Thus, in accordance with 35 U.S.C. §103(c), the '706 patent is not prior art to the present application.

Since the '706 patent cannot not be used as a valid reference against the present application, the basis of the instant §103(a) rejection no longer exists. As such, withdrawal and reconsideration of the instant rejection is respectfully requested.

Since the '706 patent and the present application are owned by the same entity, to avoid any potential obviousness double patenting rejection, applicants are enclosing a terminal disclaimer over the '706 patent.

In view of the foregoing remarks, it is firmly believed that the subject application is in condition for allowance, which action is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Mark J. Cohen". The signature is fluid and cursive, with the first name "Mark" and last name "Cohen" clearly distinguishable.

Mark J. Cohen

Registration No. 32,211

Scully, Scott, Murphy & Presser, P.C.  
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Garden City, New York 11530  
(516) 742-4343

Enclosure: Extract from the Trade Register; Terminal Disclaimer  
MJC/AZ:dk

NATIONAL BOARD OF PATENTS AND REGISTRATION OF FINLAND

EXTRACT FROM THE TRADE REGISTER

Company name: Danisco Sweeteners Oy

Business Identity Code: 1657362-0  
Company Registered: 01.05.2001  
Company Form: limited liability company  
Domicile: Kotka

Company's Contact Information:

Mailing Address: P.O.Box 213, 48101 Kotka

Visiting Address: Sokeritehtaan tie 10, 48210 Kotka

Register entries:

COMPANY NAME (registered 24.09.2001)  
Danisco Sweeteners Oy.

DOMICILE (registered 19.08.2005)  
Kotka.

ESTABLISHMENT (registered 01.05.2001)  
The assets and liabilities of a company named Danisco Finland Oy, Business ID 0114422-5 are transferred to following companies named Danisco Finland Holding Oy, Danisco Sweeteners Finland Oy and Danisco Sugar Finland Oy which are established according to the draft terms of division signed on December 04, 2000.  
The Articles of Association of a company named Danisco Sweeteners Finland Oy were approved at the Annual General Meeting on December 08, 2000. The registration authority has granted a permission to implement the division.

SHARE CAPITAL (registered 01.05.2001)  
Share capital: €10,000,000.00, paid in full.  
Number of shares: 100  
Nominal value of a share: €100,000.00.

BOARD OF DIRECTORS (registered 18.09.2007)  
Chairperson:  
Nicholas James Dunning  
Ordinary members:  
Marianne Rørslev Bock  
Bengt Gunnar Lindholm  
Henrik Birgersson Sundén

OTHER MANAGEMENT (registered 01.12.2001)  
Managing Director:  
Henrik Birgersson Sundén

LEGAL REPRESENTATION (registered 01.05.2001)  
Under the Companies Act, the Company's name is signed by the  
Board of Directors.

SIGNING ON BEHALF OF THE COMPANY (registered 01.05.2001)  
According to the articles of association, the company name is  
signed by the chairman of the board of directors and by the  
managing director, each on his/her own, and by two board members  
together.

REPRESENTATION RIGHTS (registered 14.05.2008)

Antti Vilhelm Becker  
Olli-Pekka Eroma  
Ernst Håkan Gros  
Alpo Antero Hagqvist  
Heikki Olavi Heikkilä  
Pirjo Irene Ihalainen  
Pasi Akseli Keipinen  
Eija Hannele Kemppilä  
Ilkka Ilari Kruus  
Sisko Katariina Posti  
Marja-Leena Sarkki

Any two of the persons authorised thereto represent the company  
jointly, or each of them individually together with a Board  
member.

IMPLEMENTATION OF MERGER (reg.01.12.2001 - 30.11.2006)  
By a permission granted by the registration authority Xyrofin Oy  
Business ID 0138703-2, has merged with a company named  
Danisco Sweeteners Oy Business ID 1657362-0.

COMPANY NAME HISTORY:

24.09.2001 - Danisco Sweeteners Oy  
01.05.2001 - 23.09.2001 Danisco Sweeteners Finland Oy

Helsinki, 11 December 2008

For a true copy of the extract:

Tuija Surojegin  
Administrative Officer



Fee €91.50